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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/328,626	06/09/1999	STEVEN A. BOVE	245-111	7062

570 7590 06/04/2003

AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103-7013

EXAMINER

FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/328,626

Applicant(s)

Bove et al

Examiner

Feltan

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on April 08, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

DETAILED ACTION

1
2 1. Receipt of the amendment after final filed April 8, 2003 amending claims 8, 22, 37 and
3 51 are acknowledged and will be entered.

Personal Interview

4
5
6 2. As per the personal interview on April 3, 2003 with Applicant and Applicants'
7 representative, the finality of the December 3, 2002 Office Action is withdrawn and an updated
8 search has been performed with consideration of the patentability of the present application.

Response to Arguments

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10
11 3. Applicant's arguments with respect to claims 1-58 have been considered but are moot
12 in view of the new ground(s) of rejection.

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallman (US 6,161,098).

Regarding claims 1 and 15:

Wallman discloses a computerized process, product and program for automating and executing investment planning for a client comprising:

(a) inputting into a computer data regarding the client's desired asset portfolio(see Wallman col. 7, ll. 36+) , as in

(b)...desired allocation (see Wallman, col. 9, ll. 17-24),

(c)... preferred domain (see Wallman, col. 9, ll. 17-24)

(d)...to automatically generate financial transaction recommendations for modifying the clients current asset portfolio to reach as close as possible to the desired asset allocation and preferred domain (see Wallman, col. 9, ll. 17-24)

1 (e) displaying the recommendations on a summary report for review by the client (see
2 Wallman, col. 7, ll. 1-19).

3 Wallman fails to disclose viewing displayed recommendations on a summary report by
4 the file manager, however it would have been obvious for an artisan at the time of the
5 invention to display recommendations to a financial manager because an artisan would
6 recognize that financial managers may have an expertise and judgement to discern whether or
7 not the invention's recommendation would be in the best interest of their clients. Thus to
8 employ a financial manager to view various portfolio recommendation would be an obvious
9 expedient well within the ordinary skill in the art.

10
11 **Regarding claims 2 and 16:**

12 Wallman discloses wherein step(d) includes determining tax impacts of potential sell
13 transactions, the recommendations being selected to minimize the tax impacts (see Wallman,
14 Abstract, col. 3, ll. 36-47).

15
16 **Regarding claims 3 and 17:**

17 Wallman discloses wherein the summary report includes tax impacts of at least some of
18 the recommendations (see Wallman, col. 7, ll. 1+).

19
20 **Regarding claims 4 and 18:**

1 Wallman discloses, (f) inputting into a computer data regarding the clients asset
2 portfolio preferences, including current assets that the client wishes to hold or sell, and
3 constraints on asset selling (see Wallman, col. 7, ll. 36+), wherein, step

4 (d) further includes using the data in step (f) to automatically generate the financial
5 transaction recommendations (see Wallman, col. 7, ll. 1+).
6
7
8

9 **Regarding claims 5 and 19:**

10 Wallman discloses wherein step (d) includes determining transaction costs of potential
11 sell transactions, the recommendations being selected to minimize the transaction costs (see
12 Wallman 7, ll. 1+).

13
14 **Regarding claims 6 and 20:**

15 Wallman discloses wherein the summary report includes the transaction costs of at least
16 some of the recommendations (see Wallman, col. 7, ll. 61+).

17
18 **Regarding claims 7 and 21:**

19 Wallman discloses wherein the client's current asset portfolio includes repositionable
20 assets, non-repositionable assets and possibly repositionable assets, and step (d) includes a

1 recommendation to hold the client's possibly repositionable assets if the client's new asset
2 location will be within a predetermined percentage of the desired asset allocation after selling
3 all the client's repositionable assets (see Wallman, col. 7, ll. 1+).

4
5 **Regarding claims 9 and 23:**

6 Wallman discloses wherein the client's current asset portfolio includes repositionable
7 assets, non-repositionable assets and possibly repositionable assets, and step

8 (d) includes treating the possibly repositionable assets as non-repositionable assets
9 when making the current asset portfolio modifications (see Wallman, col. 9, ll. 17-24).

10
11 **Regarding claims 10 and 24:**

12 Wallman discloses wherein the client's current asset portfolio includes repositionable
13 assets, non-repositionable assets and possibly repositionable assets, and step

14 (d) includes a recommendation to sell the client's repositionable asset until the tax
15 cost of selling equals a predetermined percentage of the client's current asset portfolio (see
16 Wallman, col. 9, ll. 17-24).

17
18 **Regarding claims 11 and 25:**

19 Wallman discloses wherein recommendations include recommendations to (i) add
20 specific amounts of shares to currently held mutual funds, and (ii) open one or more new

1 mutual funds and contribute specific amounts of shares to the new funds (see Wallman, col. 7,
2 ll. 1+)

3
4 **Regarding claims 13 and 27:**

5 Wallman discloses wherein step (d) includes developing target portfolio amounts and
6 adjusted target portfolio amounts for each asset category in the desired asset allocations (see
7 Wallman, col. 9, ll. 17-24) .

8
9
10 **Regarding claims 14 and 28:**

11 Wallman discloses (f) inputting information regarding the client which is necessary to
12 determine the client's desired asset allocation and the client's preferred domain (see Wallman,
13 col. 9, ll. 17-24); and

14 (g) automatically determining the client's desired asset allocation and the client's
15 preferred domain and using the results as the data inputs in steps (b) and (c) .

16
17 **Regarding claims 29:**

18 Wallman discloses wherein step (e) further comprises communication the specific
19 recommendations for selling amounts of selected current assets and specific recommendations
20 for buying amounts of one or more investment funds to a trade execution computer which

1 automatically performs the necessary transactions to execute the buy/sell recommendations
2 (see Wallman, col. 7, ll. 1-19)
3

4 **Regarding claims 30 and 44:**

5 (see explanation for claims 2 and 16)
6

7 **Regarding claims 31 and 45:**

8 (see explanation for claims 2 and 16)
9

10 **Regarding claims 32 and 46:**

11 see explanation for claims 3 and 17)
12

13 **Regarding claims 33 and 47:**

14 see explanation for claims 4 and 18)
15

16 **Regarding claims 34 and 48:**

17 see explanation for claims 5 and 19)
18

19 **Regarding claims 35 and 49:**

20 see explanation for claims 6 and 20)

1 **Regarding claims 36 and 50:**

2 see explanation for claims 7 and 21)

3
4 **Regarding claims 38 and 52:**

5 see explanation for claims 9 and 23)

6
7 **Regarding claims 39 and 53:**

8 see explanation for claims 10 and 24)

9
10 **Regarding claims 40 and 54:**

11 (see explanation for claims 11 and 25)

12
13 **Regarding claims 42 and 56:**

14 (see explanation for claims 13 and 27)

15
16 **Regarding claims 43 and 57:**

17 (see explanation for claims 14 and 28)

18
19 **Regarding claims 58:**

20 (see explanation for claims 29)

1 **Regarding claims 59-62:**

2 (see Alden, col. 36, ll. 34+)

3

4 ***Conclusion***

5

6 6. Any inquiry concerning this communication or earlier communications from the examiner
7 should be directed to ***Daniel S. Felten*** whose telephone number is (703) 305-0724. The
8 examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday.
9 Any inquiry of a general nature relating to the status of this application or its proceedings should
10 be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor
11 ***Vincent Millin*** whose telephone number is (703) 308-1065.

12

13 7. Response to this action should be mailed to:

14

15 Commissioner of Patents and Trademarks

16 Washington, D.C. 20231

17

18 for formal communications intended for entry, or (703) 305-0040, for informal or draft
19 communications, please label "Proposed" or "Draft".

20 Communications via Internet e-mail regarding this application, other than those under 35
21 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be
22 addressed to [*daniel.felten@uspto.gov*].

23

24

1 All Internet e-mail communications will be made of record in the application file. PTO
2 employees do not engage in Internet communications where there exists a possibility that
3 sensitive information could be identified or exchanged unless the record includes a properly
4 signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly
5 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
6 Trademark on February 25, 1997 at 1 195 OG 89.


HANI M. KAZIMI
PRIMARY EXAMINER



DSF

May 31, 2003